

REMARKS

Claim 24 has been amended. Claims 28-34 have been added. Claims 13-24 and 28-34 are now pending in the Application. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

Claim 24 has been amended to correct a punctuation error.

The Pending Claims Are Not Anticipated by the Applied Art

Claims 13-24 were rejected under 35 U.S.C. § 102(e) as being anticipated by Zajkowski, et al. U.S. Patent No. 6,705,517 (“Zajkowski”).

These rejections are respectfully traversed.

The Features Recited in Applicants’ Claims

Patentably Distinguish Over Zajkowski

In the Action claims 13-24 were rejected under 35 U.S.C. § 102(e) as being anticipated by Zajkowski. These rejections are respectfully traversed. Applicants’ response to these rejections is based on the Office’s referenced interpretation of Zajkowski. Thus, any change in the Office’s interpretation of Zajkowski shall constitute a new ground of rejection.

As indicated in Applicants’ official Filing Receipt and Preliminary Amendment, the present Application is a Divisional of U.S. Application Serial Number 09/957,982 filed September 21, 2001 (now U.S. Patent No. 6,672,505). In addition, Applicants’ present Application and U.S. Application Serial Number 09/957,982 claim benefit of U.S. Provisional

Application No. 60/235,587 filed on September 27, 2000 (“Applicants’ Provisional”). It is respectfully submitted that Applicants’ Provisional fully supports all of the pending claims in the present Application. For example, see Figures 6-8; Page 22, line 14 to page 27, line 16 of Applicants’ Provisional.

Zajkowski was filed on April 19, 2002 and claims benefit of U.S. Provisional Application No. 60/285,724 filed on April 23, 2001 (“Zajkowski’s ‘724 Provisional”). Applicants’ Provisional filing date of September 27, 2000 is earlier than the filing date of Zajkowski and the filing date of Zajkowski’s ‘724 Provisional. Thus the Specifications for Zajkowski and Zajkowski’s ‘724 Provisional do not qualify as prior art under 35 U.S.C. § 102(e) with respect to the pending claims in the present Application.

In addition, Zajkowski is a continuation-in-part (CIP) application of 09/193,787 filed on November 17, 1998, which is a continuation-in-part application of International Application PCT/US97/21422 filed on November 25, 1997. These Non-Provisional parent Applications of Zajkowski claim benefit of U.S. Provisional Application Nos. 60/098,907 filed September 2, 1998; 60/095,626 filed August 7, 1998; 60/091,887 filed July 7, 1998; and 60/031,956 filed November 27, 1996. These Provisional and Non-Provisional Applications with filing dates earlier than Applicants’ Provisional filing date are referred to herein collectively as “Zajkowski’s Earlier Applications”.

Although Zajkowski’s Earlier Applications have filing dates earlier than the filing date of Applicants’ Provisional filing date, Applicants respectfully submit that the Action has failed to show that the pending claims are anticipated by Zajkowski’s Earlier Applications. Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of

the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Also, anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 822 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987). It is respectfully submitted that the Action does not meet these burdens.

The Action discusses elements allegedly found in Zajkowski which correspond to Applicants' pending claims 13-24. The specific columns and line numbers pointed out in the Action to support the rejection correspond to Zajkowski's issued patent Specification which was filed as a non-provisional application on April 19, 2002. As discussed previously, this April 19, 2002 filing date does not qualify as prior art. Thus, to legally reject Applicants' pending claims under 35 U.S.C. § 102(e), the Office must establish that one of Zajkowski's Earlier Applications contains all of the elements of the claimed invention arranged in the manner recited in the claim. The Office has failed to perform this analysis.

For example, the Action asserts that Column 9, line 30 to Column 10, line 67 and Figure 4-all) are relevant to one or more features recited in Applicants' pending claims. This referenced portion of Zajkowski refers to "certificates" (218, 219) shown in Figure 4. This rejection appears based on the presumption that the certificates (218, 219) described in Zajkowski correspond to the "certificate" recited in the claims. However, the term "certificate" is not found in Zajkowski's Earlier Applications. Further, Zajkowski's Earlier Applications do not have Drawings which include Zajkowski's Figures 4-15 relied on in the Action to support the

rejection. Consequently, as not all of the specific portions of Zajkowski pointed out in the Action to support the rejections of claims 13-24 have been shown by the Office to be present in Zajkowski's Earlier Applications, the 35 U.S.C. § 102(e) rejection of claims 13-24 is not proper and should be withdrawn.

In addition, the present Application and Zajkowski's Earlier Applications, at the time the invention of the present Application was made, were owned by the same entity or subject to an obligation of assignment to the same entity, namely Diebold, Incorporated. It follows that under 35 U.S.C. § 103(c) Zajkowski is also disqualified from being used in a rejection under 35 § U.S.C. 103(a) against the claims of the present Application.

The New Claims

Claim 28 is an independent claim directed to a method for configuring a cash dispensing automated teller machine. The method includes verifying through operation of the at least one processor that the at least one serial number included in the at least one certificate corresponds to at least one serial number associated with at least one hardware device of the ATM. Support for claim 28 is found in the Specification (e.g., Page 8, lines 1-13; Page 27, line 17 to page 28, line 2) and original claims 18-19.

Claims 29-34 depend from claim 28. Support for these new claims is found in the Specification, original claims and Drawings. No new matter has been added. None of the cited references alone or in combination discloses or suggests the features and relationships that are specifically recited in the new claims 28-34. These claims recite features, relationships and steps recited in the original claims and are allowable for at least the same reasons. As nothing in the

cited art discloses nor suggests the features and relationships that are specifically recited in the new claims, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Applicants' invention, it is respectfully submitted that the new claims are allowable for these reasons.

Additional Claim Fees

No fee is due with the submission of this Response. However, for any other fees due associated with the prosecution of this Application, please charge Deposit Account No. 09-0428 of InterBold.

Conclusion

The Office has failed to show that the Applications for which Zajkowski claims benefit thereof and which were filed prior to Applicants' Provisional show each of the elements, features, relationships, and steps recited in Applicants' pending claims. Thus, the Office has not established that claims 13-24 are anticipated by Zajkowski under 35 U.S.C. § 102(e). All of the pending claims are allowable on this basis. Allowance of all of Applicants' pending claims is therefore respectfully requested. The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted,



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